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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/659,796

09/11/2003

David Arditi

PI895US

5241

8968 7590 06/04/2007  
DRINKER BIDDLE & REATH LLP  
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CHICAGO, IL 60606

EXAMINER

YALEW, FIKREMARIAM A

ART UNIT

PAPER NUMBER

2136

MAIL DATE

DELIVERY MODE

06/04/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/659,796	<b>Applicant(s)</b> ARDITI ET AL.	
	<b>Examiner</b> Fikremariam Yalew	<b>Art Unit</b> 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

DETAILED ACTION

1. The office action is in reply to an amendment filed on 03/12/2007. Claims 1,8,12-14 have been amended. Claims 1-14 are pending.
2. Examiner withdrawal the previous U.S.C 101 rejections based on applicant amendment.

***Response to Arguments***

3. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandhu et al (US Patent 6,970,562 B2) in view of Inada et al (US Pub No 2004/0103316 A1).

1. As per claims 1,8,12: Sandhu discloses a method/computer program/device for applying an electronic signature from a client station, comprising the steps of: /A/

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authenticating the client station at a server, thereby establishing an authenticated communication channel between the client station and said server (Col 4 lines 1-9); /B/ generating a private key/public key pair at the client station (Col 3 lines 52-59 and col 3 lines 23-33); /C/ sending from the client station to the server, via the authenticated channel, a request for a signature certificate, generated by means of at least the public key, request providing to the server information pertaining to at least the public key and excluding the private key(See col 4 lines 1-33); /D/ sending from the server to the client station, via the authenticated channel, a signature certificate provided in response to said request(See col 4 lines 1-33); /E/ calculating a cryptographic signature at the client station by means of the private key, then destroying the private key at the client station(col 3 lines 28-50 and col 4 lines 34-55); and

Sandhu does not explicitly teach /F/ formatting the calculated signature with the aid of the signature certificate received by the client station via the authenticated channel (See 0057,0062).

However Inada disclose formatting the calculated signature with the aid of the signature certificate received by the client station via the authenticated channel (See 0057,0062).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the an electronic signature from a client station disclosed by Holloway to include formatting the calculated signature with the aid of the signature certificate received by the client station via the authenticated channel. This modification would have been obvious because a person having ordinary skill in

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the art would have been motivated to do so, as suggested by, Inada (0005) in order to provide a method for managing electronic document formats capable of preventing the recipient of the document from being deceived regarding the document's required format.

2. As per claim 2: the combination of Sandhu and Inada disclose the method wherein steps /C/ and /E/ are executed in parallel at the client station (See Sandhu col 3 lines 28-50 and col 4 lines 34-55).

3. As per claim 3: the combination of Sandhu and Inada disclose wherein steps /B/, /C/, /E/ and /F/ are at least partially executed at the client station under the control of a program downloaded from the server in response to step /A/. (See Sandhu col 4 lines 21-41)

4. As per claim 4: the combination of Sandhu and Inada disclose the method wherein step /A/ comprises mutually authenticating the server and the client station (See Sandhu col 4 lines 21-42).

5. As per claim 5: the combination of Sandhu and Inada disclose the method comprising the further step of verifying, at the client station, the signature certificate received via the authenticated channel (See col 3 lines 23-35 and col 4 lines 21-42).

6. As per claims 6,13: the combination of Sandhu and Inada disclose wherein the signature certificate obtained by the server has a validity period of at most one day. (See Sandhu col 3 lines 50-67).

7. As per claim 7: the combination of Sandhu and Inada disclose the method comprising the preliminary step of registering the client station with respect to a certification authority with which the server cooperates, or with respect to a registration authority associated with said certification authority (See Inada Fig 1 steps 30,50).
8. As per claim 9: the combination of Sandhu and Inada disclose a Computer program product wherein the instructions for transmitting the signature certificate request and the instructions for calculating the electronic signature and then for destroying the private key are executable in parallel (See Sandhu col 3 lines 28-50 and col 4 lines 34-55).
9. As per claim 10: the combination of Sandhu and Inada disclose a Computer program product wherein at least some of said instructions form part of a program written in a mobile code language and downloadable from said server (2) after establishment of the authenticated channel (See Sandhu col 4 lines 21-42).
10. As per claims 11,14: the combination of Sandhu and Inada disclose a Computer program product wherein said instructions further include instructions for verifying the signature certificate received via the authenticated channel (See Sandhu See col 3 lines 23-35 and col 4 lines 21-42).

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fikremariam Yalew whose telephone number is 5712723852. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moazzami Nasser, can be reached on 5712738300. The fax phone number for the organization where this application or proceeding is assigned is 571-272-4195.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Fikremariam Yalew

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05/16/07

FA

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5,27,07